

Amendment and Response Regarding Election of Species

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Serial No. 10/019,643

Filed: December 28, 2001

METHOD AND COMPOSITION FOR AFFECTING REPRODUCTIVE SYSTEMS

REMARKS

Claim 4 having been amended, the pending claims are claims 4-9, 12-23 and 27-29. The amendment to claim 4 is supported by claim 4 as originally filed.

Restriction Requirement and Species Election*Linking claim*

Claim 4 is amended to restore it to its originally filed form. Applicant submits that claim 4, as originally filed, is a linking claim pursuant to MPEP 809.03. Specifically, claim 4 is generic to and links the inventions of Group III (claims 4-9, 12-22 and 27-29, drawn to a method for treating or preventing a reproductive disorder using zona pellucida protein), and Group IV (claims 4-9, 12-22, 28 and 29, drawn to a method for treating or preventing a reproductive disorder using DNA encoding zona pellucida protein).

The requirement for restriction between the invention of Groups III and IV is predicated upon the nonallowability of a linking claim (claim 4). It is respectfully submitted that, should claims to a method for treating or preventing a reproductive disorder using zona pellucida protein (Group III) be found free of the prior art, claim 4 should be fully examined for patentability in accordance with MPEP 809, and the restriction requirement should be modified to eliminate the restriction between Groups III and IV.

Species election (organism)

In response to the Office Action mailed April 8, 2003, indicating that the Applicant is required to elect a species selected from a method for treating reproductive disorder or in i) birds; ii) fish; iii) reptile; iv) amphibian; v) insect; vi) arachnid; vii) oocyte producing parasite and viii) rabbit with a zona pellucida protein, Applicant elects, with traverse, a method for treating reproductive disorder in **birds** for prosecution on the merits and to which the claims shall be restricted if no generic claim is finally held allowable.

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Pursuant to MPEP 809.02(a), the following is a listing of all claims readable on the elected species: claims 4-6, 12-23 and 27-29.

The Examiner indicated that claims 4, 12-19, 21, 23, 27 and 28 are generic. However, Applicant submits that in addition to the claims identified by the Examiner, claims 5, 22 and 29 are also generic. Claim 5, 22 and 29 are Markush-type generic claims that recite a plurality of species, one of which is "bird". MPEP 803.02.

An Examiner's action subsequent to the election of species should include a complete action on the merits of all claims readable on the elected species. MPEP 802.02(c). It is understood that the generic claims will be examined fully with respect to the elected species and that, if no prior art is found that anticipates or renders obvious the elected species, the search will be extended to the extent necessary to determine the patentability of the generic claims. Upon allowance of a generic claim, it is further understood that Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claims as provided by 37 C.F.R. 1.141.

Species election (reproductive disorders)

Applicant notes that a requirement for species election among a plurality of reproductive disorders set out in the Office Action mailed December 24, 2002, was overlooked, and apologizes for the oversight. As this species election requirement was not repeated in the Office Action mailed April 8, 2003, Applicant assumes it has been withdrawn. If Applicant is not correct in this assumption, the Examiner is requested to repeat the species election to clarify the record, and Applicant will timely respond.

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METHOD AND COMPOSITION FOR AFFECTING REPRODUCTIVE SYSTEMS**SUMMARY**

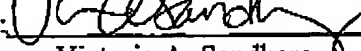
It is believed the application is condition for examination, and that the claims are in condition for allowance. The Examiner is invited to contact Applicant's Representatives at the below-listed telephone number if it is believed that prosecution of the instant application can be in any expedited or assisted thereby.

Respectfully submitted,

FAYRER-HOSKEN, ET AL.


By,
Muetting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228
Customer Number 26813

May 8, 2003
Date

By: 
Victoria A. Sandberg
Reg. No. 41,287
Direct Dial (612) 305-1226

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450, on this 8th day of May, 2003, at 4:10pm (Central Time).


Jill R. Aguilar

**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS
INCLUDING NOTATIONS TO INDICATE CHANGES MADE**

Serial No.: 10/019,643

Docket No.: 235.00300101

Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted.

4. (Twice Amended) A method for treating or preventing a reproductive disease, disorder, or condition in an oocyte-producing organism comprising administering to the organism an immunogenic composition comprising at least one component selected from the group consisting of (a) a polypeptide comprising a zona pellucida protein or an immunogenic fragment thereof and (b) a polynucleotide comprising a nucleotide sequence encoding a polypeptide comprising a zona pellucida protein or immunogenic fragment thereof.